

Application Serial No. 09/539,228
Page 4 of 8

REMARKS

This response is intended as a full and complete response to the final Office Action mailed December 29, 2004. In the Action, the Examiner notes that claims 1-8 are pending, of which claims 1-8 stand rejected. By this response, claims 1, 5, 6 and 7 are amended, and claims 2-4 and 8 continue unamended.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Rejections Under 35 U.S.C. §103

A. Claims 1 and 5-8

The Office action has rejected claims 1 and 5-8 under 35 U.S.C. §103 as being unpatentable over IEEE Publication, "The Use of Multicast Delivery to Provide a Scalable and Interactive Video-on-Demand Service" by Almeroth et al. (hereinafter "Almeroth") in view of the Examiner's Official Notice. The Applicants respectfully traverse that rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). The Applicants submit Almeroth does not teach or suggest the applicants' invention as a whole.

Almeroth discloses a multicast delivery system that provides requested specific video (and audio) content in near on-demand fashion. A subscriber contacts a network requesting specific content. The network then assigns the subscriber a time slot in which it will receive the requested specific content. Multiple subscribers can be added

Application Serial No. 09/539,228
Page 5 of 8

to that assigned time slot. Other subscribers are assigned other time slots to receive the requested specific content. The requested specific content is then obtained from a server and sent to all of the subscribers (multicast) of each time slot at the start of that time slot. Based on various interactions between a subscriber and the network, such as pause or fast forward, a given subscriber can be shifted into another time slot.

In contrast, the Applicants invention recited in independent claims 1 and 5 (and similarly claims 6-7) relate to sending messages from a transport stream generator to a terminal. For convenience, those claims are:

"1. A digital message from a transport stream generator to a terminal, the digital message comprising:
a list of demand-cast streams that are available in a transport stream being transmitted from the transport stream generator, each of said demand-cast streams comprising a respective program guide page; and
a different demand-cast stream added to said list in response to a request by said terminal, said different demand-cast stream being accessible from said list as long as at least one other terminal is associated with said different demand-cast stream." (emphasis added).

"5. A method for communicating from a transport stream generator to a terminal, the method comprising:
sending, to the terminal, a list of demand-cast streams that are available in a transport stream being transmitted from the transport stream generator, each of said demand-cast streams comprising a respective program guide page, wherein said list comprises a different demand-cast stream requested by the terminal, said different demand-cast stream being accessible from said list as long as one other terminal is associated with said different demand-cast stream." (emphasis added).

In claims 1 and 5 (and similarly claims 6-7) the messages are *lists* of the available demand-cast streams in a transport stream. Those demand-cast streams comprise program guide pages. Thus, the invention recited in claims 1 and 5 relate to sending messages that inform a terminal what program guides are available in a transport stream. Furthermore, in those claims a demand-cast stream is added to the list in response to a request by a terminal.

With all respect to the Examiner, Almeroth has nothing to do with sending messages to a terminal. Almeroth teaches adding transmissions to a transport stream

Application Serial No. 09/539,228
Page 6 of 8

so that it can be accessed by subscribers who asked for a specific program, as opposed to IPG pages.

Furthermore, the Examiner's contention that it is inherent that the server must keep track of all the streams that it has created and to provide this information to the client so the client can jump to different streams is incorrect. For a missing element to be inherent, "extrinsic evidence must make clear that the missing descriptive matter is necessarily present and in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999) (internal quotations omitted) (emphasis added).

Although a server may keep track of all the streams that it has created, it is not inherent or necessary that this information be provided to the client (i.e., the set-top terminal). Moreover, nowhere in the cited reference or the Examiner's Official Notice is there any teaching or suggestion that the digital messages sent to a terminal (i.e., set-top box) are sent from a transport stream generator. Such messages, if they were sent by the combined prior art references, could be sent by another element of the service provider equipment, such as the session manager, and via a different path, such as an out of band channel. Therefore, even if the server does indeed keep track of the streams that it has created for the client terminals, there is no teaching or suggestion in the combined references of how such tracking is performed.

The Applicants' invention provides that the transport stream generator of the service provider equipment sends digital messages to the terminal. The digital messages comprise a list of demand-cast streams that are available in a transport stream being transmitted from the transport stream generator, where each of the demand-cast streams comprise a respective program guide page. Since the combination of Almeroth and the Examiner's Official Notice fails to teach or suggest that the digital messages comprise a list of demand-cast streams comprising respective program guide pages, the combined references fail to teach or suggest the Applicants' invention as a whole.

As such, the Applicants submit that independent claims 1, 5, 6, and 7 are not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable

Application Serial No. 09/539,228
Page 7 of 8

thereunder. Furthermore, claim 8 depends from independent claim 7 and recites additional features thereof. As such, and at least for the same reasons as discussed above, the Applicants submit that dependent claim 8 is also that obvious and fully satisfies the requirements under 35 U.S.C. §103 as patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

B. Claims 2-4

The Examiner rejected claims 2-4 under 35 U.S.C. §103(a) as being unpatentable over Almeroth in view of U.S. Patent No. 6,314,569 to Chernock et al. (hereinafter "Chernock"). The Applicants respectfully traverse the rejection.

Claims 2-4 are dependent directly or indirectly from independent claim 1. For at least the reasons as set forth above with respect to independent claim 1, Applicants submit that dependent claims 2-4 are not rendered obvious by Almeroth.

Applicants also submit that Chernock does nothing to address the deficiencies of Almeroth. Chernock discloses a method of displaying multimedia content and personalized audio, video, and graphic content. Chernock further discloses automatic object recognition and insertion of personalized information into "holes" found by that recognition.

Applicant's claim 1 relates to sending messages comprised of lists of the available demand-cast streams in a transport stream. Those demand-cast streams comprise program guide pages. Furthermore, a demand-cast stream is added to the list in response to a request by a terminal. Nothing similar is found in or suggested by Chernock.

As such, Applicants submit that claim 1 remains allowable over Chernock. Furthermore, since claims 2-4 depend from allowable claim 1 and recite additional limitation, those claims are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejection of claims 2-4 be withdrawn.

Application Serial No. 09/539,228
Page 8 of 8

CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

2/3/05

EJ Wall

Eamon J. Wall, Registration No. 39,414
MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808
Attorney for Applicant(s)